

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-49 are pending in this application. Claims 1-11, 48, and 49 are allowed.

Claims 12-47 were rejected under 35 U.S.C. § 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.

Addressing the rejection of Claims 12-47 under 35 U.S.C. § 251, it is respectfully submitted that Claims 12-47 do not improperly recapture deliberately canceled claimed subject matter.

Each of independent Claims 12 and 30 recites "wherein the printer module and the scanner module are stacked one upon another in a stack, and the scanner module is at an uppermost position of the stack".

According to that claimed feature, a plurality of modules are stacked vertically in an image forming apparatus. It is thus harder than a conventional apparatus to install or set the modules in such an arrangement because placement of the modules is restricted or have a lesser degree of freedom. Therefore, it may be important to decrease the number of cables, including the power supply cable used in such an apparatus, such that installing or setting the apparatus can be simplified. By utilizing the structure as recited in independent Claims 12 and 30, the number of cables in an uppermost scanner module usually requiring a most frequent replacement can be decreased. As a result, maintenance and setting of the apparatus including replacement of the scanner module can be simplified.

Such features recited in Claims 12 and 30 recite material limitations, and thereby avoid the recapture doctrine.

Applicants note that the outstanding Office Action performs a three step analysis of the claimed subject matter. However, Applicants respectfully submit that the analysis in the third step is incomplete.

Specifically, at page 6, the outstanding Office Action states:

### THIRD STEP ANALYSIS

The second inquiry is whether the REISSUED claims were materially narrowed in other respects to avoid the recapture rule. The examiner submits that the claims were narrowed in other respects. The REISSUE claims 12 and 30 were narrowed in that the first and second modules include at least a power input means for supplying power to the scanner and printer. This limitation is thought to be narrowed for the reason that the limitation did not appear in claims 1-11 of the parent case of the instant REISSUE Application.

The above-noted third step analysis is incomplete. That is, the above-noted third step analysis recognizes that reissue Claims 12 and 30 are more narrow in certain respects. However, the above-noted third step analysis did not take the further step of determining whether those limitations have a “material” aspect to them, and would thereby avoid the capture rule.

Specifically, and as discussed in further detail below, the recapture doctrine can be avoided if claims are narrowed such that the narrowing aspect have a “material” aspect to them. Applicants respectfully submit that is clearly the case with respect to Claims 12-47.

The outstanding rejection under 35 U.S.C. § 251 is also maintained based on consideration of *Jaswant S. Pannu and Jaswant S. Pannu, M.D., P.A., v. Storz Instruments, Inc.* (Fed. Cir. 2001).

In addressing the situation in the Pannu case, in the present application it is clear that new Claims 12-47 recite significant additional limitations never considered during prosecution of original Claims 1-11. That is necessarily the case as Examiner Grant previously indicated during prosecution of the present application that Claims 12-47 recite

allowable subject matter over any cited prior art. That is, Claims 12-47 have been recognized as reciting limitations neither taught nor suggested by the applied art. That is also reiterated in the outstanding Office Action as Claims 12-47 are not rejected over any cited prior art.

As such, the only conclusion that can be drawn from the fact that Claims 12-47 recite allowable subject matter is that Claims 12-47 recite features neither taught nor suggested by the applied art. If Claims 12-47 are broader in certain aspects in comparison with Claims 1-11, it must also necessarily be the case that Claims 12-47 recite additional limitations that are neither taught nor suggested by the applied art. Or else, Claims 12-47 would have been rejected as Claims 1-11 were rejected during their prosecution. That position even appears to be recognized in the Office Action as the "Third Step Analysis" noted above states "The REISSUE Claim 12 and 30 were *narrowed...*" (emphasis added). Thus, Claims 12-47 must be narrower in "material" aspects directed to their patentability.

Stated another way, the fact that Claims 12-47 are not rejected over any prior art, and as Claims 12-47 are broader in certain aspects in comparison with Claims 1-11, Claims 12-47 must be narrower in other aspects that lead to their allowability over the prior art. Clearly limitations that make Claims 12-47 allowable over the prior art have a "material" aspect to them, and would avoid the recapture rule.

In even further detail, it is established that a reissue application will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. However, it is not the situation in the present application that Claims 12-47 of the reissue application capture previously deliberately canceled claimed subject matter.

As stated in MPEP §1412.02:

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material

aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17. (Emphasis added).

Claims 12-47 recite significant limitations that were never presented in the parent of the present application. The subject matter recited in Claims 12-47 is directed to the embodiment such as shown for example in Figure 23 in the present specification and as is discussed in column 25, lines 1-9. As is discussed in that portion of the specification, in one embodiment of the present invention as shown in Figure 23 a first electric power supply section 103 in the scanner module 100 is eliminated (see with respect to the embodiment of Figure 1) and power to the scanner module 100 is supplied through a cable from the electric power supply section 203a in the printer module 200. With such a configuration the number of parts in the entire system can be reduced as a power supply section is no longer needed in the scanner module. Thus, in that embodiment of the present invention the printer module includes the power supply for the scanner module. Such subject matter is being further pursued in Claims 12-47.

Specifically, Claims 12-29 recite that the printer module includes "a power supply having an input and an output" and the scanner module includes "a power input for connection to the output of the power supply to the printer module". Thus, in Claims 12-29 the printer module includes a power supply and the scanner module only includes an input to connect to the power supply of the printer module. Such limitations recited in Claims 12-29 are new limitations set forth in those claims that narrow the scope of Claims 12-29 with respect to original Claims 1-11. Further, it is respectfully submitted that such features as discussed above as recited in new Claims 12-29 are narrowing limitations with "material" aspects thereto, and that thus there is no recapture with respect to those claims. As discussed

above, such limitations must be "material" as they avoid the rejections of any of the originally submitted claims.

Further, Claims 30-47 also recite at least similar limitations. More specifically, new independent Claim 30, and Claims 31-47 dependent therefrom, recite that the printer module includes "means for supplying power having an input means for inputting and an output means for outputting" and that the scanner module includes "power input means for inputting power to the scanner module from the means for supplying power of the printer module and for connection to the output means of the power supply of the printer module". Similarly as discussed above with respect to Claims 12-29, such limitations as recited in new Claims 30-47 are also directed to narrowing limitations of those claims that have a "material" aspect and that are not merely "incidental", "mere verbiage", or "inherent".

Further, independent Claims 12 and 30, and the claims dependent therefrom, also recite the limitation that "wherein the printer module and the scanner module are stacked one upon another in a stack, and the scanner module is at an uppermost position of the stack". Those features are also "material" and further clarify those claims.

What the "Third Step Analysis" noted above has not addressed is the fact the narrowed independent Claims 12 and 30 are narrowed in "material" aspects, which for the reasons noted above must be the case. That "material" narrowing avoids the recapture doctrine.

In such ways, the above-noted limitations in Claims 12-47 do have a "material" aspect to them as they further define the structure of both the printer and scanner module. That is, such claim limitations are not "incidental", "mere verbiage", and would not be "inherent" to the original claims. As such, based on the guidelines provided in MPEP §1412.02 noted above, such limitations in Claims 12-47 overcome a rejection under 35 U.S.C. §251.

The basis for the outstanding rejection also cites the holding in *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997), as supporting the outstanding rejection. However, it is noted that the situation addressed in *In re Clement* is not the same situation as in the present invention. It is significant to note that in the holding in *In re Clement* an example was given of a situation in which reissue claims were broader in some aspects and narrower in other aspects than amended claims, and the Court addressed a situation that a reissue claim in question was as broad as or broader in an aspect germane to a patent rejection, but narrower in another aspect completely unrelated to the rejection, i.e. situation 3a) noted in *In re Clement* and as noted in the outstanding Office Action. That situation was addressed in *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). In that case, the Court noted that the reissue claims in question eliminated limitations inserted into the claims during prosecution of the claims, but added additional limitations of a cylindrical member being "flexible" which formed a "single" roll. In that case, the Court held that the additional limitations of the cylindrical member being "flexible" and a "single roll" did not allow those claims to escape the recapture rule because those limitations ***did not "materially narrow the claim[s]"*** (emphasis added). Again, that is contrary to the case in the present application in which the additional limitations of the "power supply" in the "printer module" providing power to the "scanner module" in Claims 12-47 ***do materially narrow*** those claims.

In such ways, it is respectfully submitted that Claims 12-47 in the present reissue application are proper and do not recapture subject matter canceled in the parent of the present application. Thus, it is respectfully submitted that the rejection of Claims 12-47 under 35 U.S.C. §251 has been traversed.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
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A handwritten signature in cursive script, appearing to read "Surinder Sachar", written over a horizontal line.

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